On page 7, line 9, after "MTFYSPAVMNYS . . ." insert – (SEQ ID NO:3) –; line 10, after "- - GYSPAVMNYS . . ." insert – (SEQ ID NO:4) –; line 13, after "having the sequence" insert – (SEQ ID NO:5) –; and line 15, after "having the sequence" insert – (SEQ ID NO:6).

On page 8, line 13, after "M T G Y ..." insert -- (SEQ ID NO:7) --; and line 14, after "TAT . . ." insert – (SEQ ID NO:8) –.

On page 9, line 1, after "CTGGTAAGTTTAGTCTTTTTGTC-3'" insert – (SEQ ID NO:9); line 2, after "GCTTCACACCAAGGACTCTTTTGAG-3'" insert – (SEQ ID NO:10); line 13, after "#13871)" insert (SEQ ID NO:11); and line 22, after "Clontech)" insert – (SEQ ID NO:12) –.

On page 10, line 1, after "#12908)" insert – (SEQ ID NO:10) –; line 7, after "Clontech)" insert – (SEQ ID NO:13); and line 8, after "#13871)" insert – (SEQ ID NO:11) –.

REMARKS

Applicants submit herewith a paper and computer readable copy of the Sequence Listing in compliance with 37 C.F.R. § 1.821 *et seq.* The Specification has been amended to include SEQ ID NOS. No new matter has been added.

Claims 1-23 are pending in the application.

The content of the attached paper entitled "SEQUENCE LISTING" and the accompanying identically labeled diskette, specifically the ASCII-encoded file therein labeled "SEQUENCE.LST", is the same. No new matter has been added.

Election Under 37 C.F.R. § 1.146

The Examiner has required restriction among the claims of:

Group I, Claims 1-16, drawn to the polynucleotide sequence comprising the SEQ ID NO:1 or encoding the polypeptide of SEQ ID NO:2, vectors encoding, cells containing the aforementioned expression vectors and a method of production and recovery of said polypeptide, classified in class 536, a subclass 23.1, for example;

Group II, Claims 17 and 18, drawn to a purified polypeptide depicted in SEQ ID NO:2, function-conservative variant thereof, classified in class 530, subclass 350/300, for example;

Group III, Claims 19-22, drawn to a method for identifying hERβ-interactive compounds, classified in class 435, subclass 7.1, for example; and

Group IV, Claim 23, drawn to antibody that recognizes hERβ, classified in class 530, subclass 387.9, for example.

The Examiner contends that these groups of claims are distinct. For example, the Examiner contends that the proteins of Group II are distinct from the nucleic acids of Group I because they are physically and functionally distinct chemical entities. The Examiner states that the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source, and that the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization.

The Examiner further contends that the protein (Group II) and antibody (Group IV) are distinct because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the cognate receptor of the protein, or in assays for the identification of agonists of the receptor protein.

The Examiner contends that the methods of Group III are distinct from the proteins of Group II because the proteins may be used for the production of antibodies. The Examiner contends that the methods are distinct and separate from the nucleic acids and methods of Group I because they use separate method steps, active agents and having different effects. The Examiner further alleges that the antibody of Group IV can not be used or made by the methods of Group III.

Finally, the Examiner contends that the antibody of Group IV is distinct and separate from the nucleic acids and methods of Group I because the nucleic acid is structurally and functionally different from the antibody.

The Examiner has also stated that a search of the art for the claims of each Group I-IV would not be co-extensive with each other.

The restriction requirement is respectfully traversed, and reconsideration is requested. However, in order to be fully responsive, Applicants provisionally elect the claims of Group I, claims 1-16.

Under 35 U.S.C. § 121 "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "'independent'"

if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01).

Moreover, under Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define products, methods for using such products, and the methods for producing such products, with biological properties so distinct as to warrant separate examination and search.

The nucleic acid of Group I encodes the polypeptide of Group II. Indeed, claim 9 and the claims dependent thereon are directed to a nucleic acid encoding the amino acid sequence of SEQ ID NO:2. A search of the nucleic acid claims of Group I, particularly of claims 9-16, would likely include a search of polypeptides of Group II to be complete. To the extent that a search of Group I would be made, it is submitted that a preponderantly coextensive search of the subject matter of Group II would result. Thus, a search of the claims of Group II would incur no additional burden on the Examiner.

Furthermore, the recombinant process of making the polypeptide need not be distinct from the product made: recombinant expression of a nucleic acid encoding a polypeptide will result in production of the polypeptide. Applicants submit that it is irrelevant that the polypeptide can be made from some other process. The relevant question is whether the process can produce some other product. See 37 C.F.R. § 1.141(b) "Where claims to all three categories, product, process of making and process of use, are included in a national

application, a three way requirement for restriction can only be made where the process of making is distinct from the product" (emphasis added). Thus, the Examiner has erroneously distinguished the product claims of Group II from the process claims of Group I. Accordingly, Groups I and II must be examined together.

Furthermore, as the Examiner has noted, the polypeptide of Group II is related to the method of Group III as product and process of using it. The invention provides a method to identify hERβ-interactive compounds, which cannot be practiced without the polypeptide. Applicants submit that it is irrelevant that the product could be used in some other process.

Finally, the polypeptide of Group II is, as the Examiner pointed out, the cognate antigen for the antibody of Group IV. As with the nucleic acid claims, Applicants submit that to the extent a search of the polypeptide would be made (and such a search must be made to thoroughly search the elected nucleic acid claims), such a search would be co-extensive with the claimed antibody, and would not pose an undue burden on the Examiner.

Moreover, contrary to the Examiner's assertion, the antibody of Group IV could be used in a method of Group III, *e.g.*, as the labeled ligand.

Accordingly, each of the claim groups II, III, and IV are related to the nucleic acids encoding the polypeptide of the invention and methods of producing the polypeptide of Group I. Applicants submit that the search and examination of all of the claims can be made without serious burden. The greater burden on both Applicants and the Examiner would result from needlessly filing, processing, and prosecuting multiple divisional applications. Therefore withdrawal of the requirement for restriction, and examination all of the claims of Groups I,

II, III, and IV (claims 1-23) on the merits, is believed to be in order.

Alternatively, Applicants respectfully submit that the Claims of Groups I, II, and III are directed to related structural, biochemical, and functional subject matter. These claims are directed to a process for making a polypeptide, the polypeptide that results from the process, and the process that uses the polypeptide. Accordingly, modification of the Requirement for Restriction and examination of Claims 1-22 is believed to be in order and is earnestly requested.

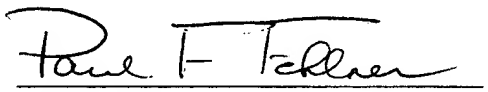
In view of the above, withdrawal, or in the alternative, modification of the Requirement for the Restriction is requested.

CONCLUSION

No fee is believed to be due. However, if any fee is due, the Commissioner is authorized to charge the Deposit Account No. 04-0100.

Early and favorable action on all of the claims is earnestly solicited.

Respectfully submitted,



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